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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/099,669 | 03/14/2002 | Joseph D. Franko SR. | 20020049,ORI | 3004 |

23595 7590 02/24/2004
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EXAMINER
ZIRKER, DANIEL R

| | |
|------------------|--------------|
| ART UNIT 1771 | PAPER NUMBER |
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DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 12/22/03

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-28

Of the above claim(s) _____ is/are pending in the application.

☐ Claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-28 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

_____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant has failed to respond to the provisional double patenting of the obviousness-type rejection set forth in paragraph No. 9 of the last Office action, Paper No. 1022. Although such an omission could be treated as a non-responsive Response, the Examiner simply repeats the provisional obviousness-type double patenting rejection set forth in paragraph No. 9 of that paper.

3. The specification is again objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for the reasons set forth in paragraph No. 2 of the last Office action, Paper No. 1022. Applicant appears to believe that cancellation of the term "permanent adhesive" from the claims will remove this grounds of rejection, but the Examiner must respectfully disagree. In fact, as applicant has noted (paragraph bridging pages 8 and 9 of the Response) applicant himself does not appear to understand just what this term entails and it is admitted that this term "has often been misused by others in the field". The Examiner can only repeat what was said in paragraph No. 2 of the last Office

action, that a vague standard with respect to a definition of a permanent adhesive is simply an invitation to experiment, and that a prospective infringer has no guidelines as to indicate what sort of adhesives would or would not read upon applicant's disclosed and also claimed genus of adhesives. Note again that "permanent adhesive material" as set forth ⁱⁿ both applicant's ^{original} claim 2 Markush grouping as well as in ^{original} independent claim 21 and dependent claim 28 is also believed to recite five subgenuses of adhesives, each of which also contain multiple pressure sensitive adhesives and other overlapping groups of adhesives as members thereof.

4. Claims 1-28 are rejected under 35 U.S.C. § 112, first paragraph as being based upon a non-enabling disclosure.

5. Claims 1, 2, 4-6, 9 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baum, Jr. et al., substantially for the reasons set forth in paragraph No. 4 of Paper No. 1022, together with the following additional observations. The Examiner believes that applicant's claim amendments are simply essentially cosmetic in nature, and note again column 3, lines 49-51 of Baum, Jr. et al. where it is taught that "adhesive means 28 may be a pressure sensitive adhesive layer or another adhesive system as is known in the art". Note also that adhesive 44 may also be modified, which is believed to mean that either pressure

sensitive adhesives or permanent adhesives or tack-free adhesive materials as claimed by applicant may be suitable for usage. Note also that applicant (Response, page 9, second complete paragraph) states that "no change in scope has been intended" with respect to the various claim amendments and also with his argument that Baum, Jr. et al. "clearly does not teach or suggest the requirement of using two different adhesive types" (Response, page 11 top paragraph) the Examiner can only note that the reference clearly teaches that various different adhesives may be suitable and it is again noted that the various classes of adhesives may well overlap.

6. Claims 3, 7, 8, 10 and 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum, Jr. et al., substantially for the reasons set forth in paragraph No. 5 of Paper No. 1022, together with the following additional reasons. The reference is again relied upon as set forth above, and what changes may have been made are each again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. Claims 1, 2, 4-6, 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Coward et al. or Hill et al. -587, substantially for reasons set forth in paragraph No. 6 of Paper No. 1022, together with the following additional

observations. The Examiner has little to add to what has been already stated, and further notes that the Abstract of Coward et al. clearly indicates that the distinction between pressure sensitive adhesives and permanent adhesives is essentially interchangeable, to which the Examiner would clearly add the newly utilized "tack-free adhesive material". Also, note again Hill et al., column 3, lines 24-28 wherein it is taught that pressure sensitive adhesives "function to effect secure affixment bonding of the pressure sensitive adhesive label 16 to the base layer 20" which again clearly appears to read upon applicant's definition of either permanent adhesives or tack-free adhesive materials. What other parameters that may exist are again each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Claims 3, 7, 8 and 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Coward et al. or Hill et al. -587, substantially for reasons set forth in paragraph No. 7 of Paper No. 1022, together with the following additional observations. The Examiner has little to add other than the fact that the references are each again relied upon substantially as set forth above, with those parameters that are not believed to be either expressly or inherently disclosed again are handled in the identical manner as previously set forth above.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc

February 17, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1800-
1700

Daniel Zinker